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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,830	01/25/2007	David Bruge	09097-8001.US00	5020

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Perkins Coie LLP
607 Fourteenth Street, NW
Washington, DC 20005

EXAMINER	
MORRIS, PATRICIA L	
ART UNIT	PAPER NUMBER
1625	

NOTIFICATION DATE	DELIVERY MODE
10/20/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

Office Action Summary	Application No.	Applicant(s)	
	10/563,830	BRUGE ET AL.	
	Examiner	Art Unit	
	Patricia L. Morris	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *6-8 and 10-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-5 and 9 are under consideration in this application.

Claims 6-8 and 10-31 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election of Group IV and the third compound from the top in the table on page 181 of the specification in the reply filed on August 12, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The restriction requirement is deemed sound and proper and will be maintained. The search will not be extended because applicants have been given a very reasonable genus that is supported by the enabling disclosure in table 2. Very few compounds are even exemplified in the specification.

The application has been examined to the extent readable on the elected compounds of formula IIb wherein X and Y are O and R^6-R^{10} represent non-heterocyclic groups as set forth in claim 4, exclusively. All additional heterocycles and heteroaryls pertain to nonelected subject matter. Claims 1-3 have only been examined to the extent readable on the elected compounds because it is not apparent that the compounds of formula IIb are even recited in claims 1-3.

Claim Rejections - 35 USC э 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is a lack of description as to how the derivatives or residues and solvates are produced and what solvates and derivatives or residues are produced in the specification. Vippagunata et al. (Advanced Drug Delivery Reviews 48 (2001) 3-26) recites on page 18 that predicting the formation of solvates of a compound and the number of molecules of solvent or water incorporated into the crystal lattice of a compound is complex and difficult. Guillory (in Brittain et al., NY:Marcel Dekker, 1999, pages 183-226, teach that solvates are formed by recrystallization of drug substances. However, not all compounds will form solvates.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for preparing the instant compound and its salts, does not reasonably provide enablement for preparing any and all unknown solvates, residues or derivatives. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification fails to prepare any solvates and derivatives or identify the solvates and derivatives obtained.

The expression substituted is employed with considerable abandon in the claim 1 with no indication given as to what the groups really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 20 years. Therefore, one must know what compound is being claimed.

The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. Applicants are referred to In re Fouche, 169 USPQ 429 CCPA 1971, MPEP 716.02(b).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The nature of the invention

The nature of the invention is the preparation of a compound, its salts, derivatives, residues and solvates.

State of the Prior Art

Predicting the formation of solvates and derivatives or residues of a compound and the number of molecules of solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvates and

hence generalizations cannot be made for a series of compounds. Note section 3.4 of Vippaguanta et al.

Substituents can have very different properties. Substituents tend to convert from less stable to more stable forms. No method exists to predict what substituent will work with any significant certainty. Substituents can convert from one form to another during the manufacturing process of a pharmaceutical drug and will change the pharmacological affects of the drug. This is why it is important to monitor the compounds during manufacture of the drug to see if it persists during manufacture.

The amount of direction or guidance and the presence or absence of working examples

The working examples in the specification fail to show how any solvates and derivatives are produced. Further, Guillory on page 199 recites that compounds originally crystallized as solvates can lose the solvent induced by heat or vacuum vaporization.

The specification fails to describe any substituent. Substituents often change into other forms during drug manufacture. Based on the unpredictability in the art, applicants are not entitled to any and all unknown subsituents.

The breadth of the claims

The breadth of the claims is drawn to the preparation of the compound, its salts, derivatives and all solvate forms.

The quantity of experimentation needed

The quantity of experimentation needed would be undue when faced with the lack of direction and guidance present in the instant specification in regards to the process of preparing all unknown solvates.

In terms of the 8 Wands factors, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of unpredictability in the art of the invention, and the poor amount of direction provided by applicants. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

Genentech Inc v. Novo Nordisk A/S (CAFC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and [p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms solvate, derivative, residue and substituted in claims 1-5 are indefinite to their meaning.

The plural 's' on "derivatives, salts, compounds and solvates" makes claims 1-5 and 9 read on mixtures rather than specific compounds.

Regarding claims 1-5, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim 9 is an improper composition claim because it fails to recite the present of an inert carrier. Further, the term "contains" is open-ended and allows for the inclusion of other active ingredients.

The terms comprising, containing and contains recited throughout claim 1 are open-ended.

No antecedent can be found for the compounds of formula IIb in claim 1. Yet claim 4 recites that formula IIb is recited in claim 1. The variables R^6-R^{10}, p, X, Y and q are not even defined in claim 1. However, claim 4 improperly depends on two claims, *i.e.,* 1 and 3.

Claim 5 improperly refer to tables in the specification since the claims fail to point out what is included or excluded in the claim. See *Ex Parte Fressola* 27 USPQ2d 1608:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Claims in utility applications [2] that define the invention entirely by reference to the specification and/or drawings, so-called "omnibus" or "formal" claims, while perhaps once accepted in American patent practice, are properly rejected under Section 112 Para. 2 as failing to particularly point out and distinctly claim the invention. See MPEP Section 706.03(h) (5th ed., rev. 14, Nov. 1992); Landis, Mechanics of Patent Claim Drafting, Section 2 (1974). This analysis is limited to claims in utility applications. Plant patent claims are defined "in formal terms to the plant shown and described." Claims in design patents are recited in formal terms to the ornamental design "as shown" or, where there is a properly included special description of the design, the ornamental design "as shown and described." MPEP Section 1503.01……The general rule is that the claims should be self-contained; that is, they should not expressly rely upon the description or drawing to give them meaning. . . . The terms "substantially as described" and the like, once much used in claims (GLASCOCK 1943 Section 5640) are now rarely seen. The Office disregards them in interpreting claims. . . . Claims consisting only in a reference to the disclosure, as "The features of novelty herein disclosed," are not allowed except in design cases……A claim which refers to the specification defeats the purpose of a claim."

There is no need to recite the specification as the claims can be clearly written to contain all of the compounds with either names or structural representations.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations

of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

Claim Objections

Claims 2 and 3 are objected to because of the following informalities: The term characterized is misspelled in line 1, claim 1 and the term consisting in claim 3, line 9, on page 11 is misspelled . Appropriate correction is required.

Allowable Subject Matter

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and if rewritten directed solely to the elected compounds indicated as being examinable, supra.

Claims 2-5 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L. Morris/
Primary Examiner, Art Unit 1625

plm
October 14, 2010